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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,876	01/29/2002	Taiji Sasage	1614.1211	2384

21171 7590 05/21/2007  
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EXAMINER
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PICH, PONNOREAY

ART UNIT	PAPER NUMBER
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2135

MAIL DATE	DELIVERY MODE
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05/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/057,876

Applicant(s)

SASAGE ET AL.

Examiner

Ponnoreay Pich

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

Claims 1-10 are pending. Applicant's amendments and arguments directed at the amended claims were fully considered, but are moot in view of new rejections presented below. The new rejections are made in light of the amendment to the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-5, and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welborn et al (US 2002/0091940) in view of Marsh (US 6,763,462).

#### **Claims 1 and 4:**

Welborn discloses:

1. Registering a second address as a receiver address in an address table for mail virus detection (paragraph 46, lines 25-28), and a corresponding first address in a respective client mail address book, for each of a plurality of clients of the local mail system (paragraph 46, lines 18-37). *The third computer is set up so as to have a receiving address of the second address—the third computer's email client used to receive emails is an address table for mail virus detection. The mock virus which contains a first address is sent to the plurality of clients of the local mail system. If a user opens the mock virus, then the first address*

*contained in the mock virus is used to create and send an email to the third computer. The mock virus can be considered a respective client's address book since it has the first address stored therein and is used to determine the address to which an email is to be sent.*

2. Determining whether an electronic mail transmitted from any one of the clients indicates the first address corresponding to the second address recorded in the address table for mail virus detection (paragraph 46 and Drawing 2, step 4).  
*Since the third computer is able to receive emails sent from clients using the first address as the receiver address, then this means that it was determined that the second address registered to the third computer is the same address as the first address, i.e. the first address corresponds to the second address.*
3. Storing information concerning the electronic mail as mail virus information in a mail virus information table in response to the first address of the electronic mail indicating the second address (paragraph 46, lines 25-37). *A list is compiled of all the users who opened the mock virus causing an email to be sent to the address of the third computer.*

Welborn does not explicitly disclose suppressing transmission of any electronic mail that includes the mail virus. However, Marsh is concerned with email virus detection. In his invention, an address or set of addresses is selected to trigger an alert that the email that a client is attempting to send may contain a virus (Fig 2; col 2, lines 39-49, 64-67 and col 3, lines 10-22). Marsh discloses that if a virus warning/alert is

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triggered, the transmission of electronic mail containing the mail virus is suppressed (col 3, lines 35-43).

In light of these two teachings by Welborn and Marsh, it would have been obvious to one of ordinary skill in the art to combine their teachings according to the limitations recited in claims 1 and 4. One skilled would have done so by designating a trap address as taught by Welborn, i.e. the third computer's address, and if any emails are sent to the trap address, suppressing transmission of the email as taught by Marsh since Marsh's teachings would lead one of ordinary skill to recognize that emails sent to the trap address are probably virus emails. One of ordinary skill would have been motivated to combine these two teachings because it would result in a virus detection system that is not reliant on software that needs to continually adapt to detect new viruses (Welborn: paragraph 15, last 4 lines).

**Claims 2 and 5:**

Welborn and Marsh both further disclose reporting a mail virus detection to at least one predetermined report address in response to the first address being indicated (Welborn: paragraph 46 and Marsh: col 3, lines 25-39).

**Claim 8:**

Welborn further discloses wherein the mail virus information indicates one or more values of a sender electronic mail address, a data size, a title, or a combination thereof, which are shown in the electronic mail indicating the first address (paragraph 46). *A list email addresses belonging to senders of the mail virus are compiled to*

*determine every one responsible for the virus emails. The list of email addresses are mail virus information.*

**Claim 7:**

The limitations recited in claim 7 are substantially similar to those found in claim 1. Claim 7 is rejected thus for substantially similar reasons as claim 1 over Welborn and Marsh. The most noticeable difference is that in claim 1, if it is determined that a first address used to send an electronic mail is the same as the second address, information concerning the electronic mail is stored in a mail virus information table. Claim 7 refers to this as detecting the electronic mail as being infected by a virus.

**Claim 9:**

Welborn further discloses storing information corresponding to the electronic mail as virus information in a virus information table in response to detecting the electronic mail as being infected by the virus (paragraph 46).

**Claim 10:**

Marsh further discloses suppressing transmission of any electronic mail that includes the virus in response to detecting the electronic mail as being infected by the virus (col 3, lines 36-41).

**Claim 11:**

Marsh further discloses reporting the virus detection to at least one predetermined report address in response to detecting the electronic mail as being infected by the virus (col 3, lines 25-39).

Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welborn et al (US 2002/0091940) in view of Marsh (US 6,763,462) in further view of Ji et al (US 5,889,943).

**Claims 3 and 6:**

Marsh discloses saving the electronic mail for further examination and for reporting the mail virus detection (col 3, lines 39-43). However, Welborn and Marsh do not explicitly disclose compressing the electronic mail indicating the first address; and attaching the compressed electronic mail to a report mail for reporting the mail virus, and reporting the mail virus detection by sending the report electronic mail to at least one predetermined address.

However, as previously established, it was well known in the art to compress electronic mail before sending it. Further, Ji disclosed attaching (virus) electronic mail to a report electronic mail for reporting mail virus detection and reporting the mail virus detection by sending the report electronic mail to at least one predetermined address (col 20, lines 40-63).

At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to further modify Welborn and Marsh's combination invention according to the limitations recited in claims 3 and 6 in light of the above. One skilled would have been motivated to send a report electronic mail containing the mail virus to at least one predetermined address as per Ji's teachings so that further examination of the virus could be conducted. Note that this was something Marsh desired (col 3, lines

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39-43). Also, further examination of the virus could lead to development of countermeasures to the virus. One skilled would have been motivated to compress the electronic mail indicating the first address before sending it to the predetermined address because it would allow the mail to be sent faster and it would allow the mail to take up less storage space. Compressing the virus infected email would also help prevent accidentally executing virus code contained in the message.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



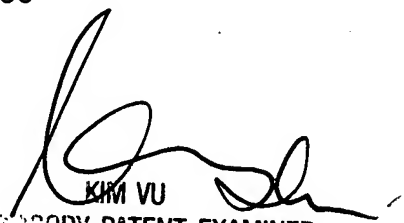
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is 571-272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 2135

PP



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